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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,603	11/14/2003	Albert F. Elcock	BCS03195	2515

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EXAMINER	
TAYLOR, BARRY W	
ART UNIT	**PAPER NUMBER**
2643	

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/713,603	ELCOCK ET AL.	
	Examiner	Art Unit	
	Barry W Taylor	2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-20 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 14 November 2003 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-5 and 7-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bierman et al (5,761,279 hereinafter Bierman).

Regarding claim 1. Bierman teaches a method of personalizing caller ID information (abstract) comprising:

storing data for at least one personalized caller id associated with a given telephone number (see abstract, col. 3 lines 19-30, col. 4 lines 5-12 wherein subscriber makes available to the service provider a photograph or other graphic representation which is stored with calling party's number);

allowing a user to select a particular personalized caller id when placing a phone call (see col. 4 lines 5-12 wherein subscriber indicates to the Central Office which facial representation is to be sent to called party's terminal); and

transmitting the data for the selected personalized caller id when the user places the phone call (see col. 3 lines 45-58 and col. 4 lines 5-28 wherein the facial representation data is presented with other calling line identification information when calling party initiates a call).

Regarding claim 2. Bierman teaches wherein the personalized caller id data comprises text (see col. 3 lines 54-58 wherein facial representation data is presented with other calling line identification information such as telephone number and/or calling party's name (i.e. text)).

Regarding claim 3. Bierman teaches wherein the personalized caller id data comprises at least one of a photo, video clip, or multimedia presentation (see col. 3 lines 19-21 and col. 4 lines 5-12 wherein photograph or other graphic representation is supplied to Central Office for storage).

Regarding claim 4. Bierman teaches wherein the personalized caller id data is communicated by a calling telephone to a called telephone a the beginning of placing the phone call (see col. 3 lines 45-58 and col. 4 lines 5-28 wherein calling party initiates telephone call with an indication to the Central Office as to which facial representation is to be sent to called party's terminal).

Regarding claim 5. Bierman teaches wherein a plurality of personalized caller id data are associated with said given telephone number (see col. 4 lines 5-12 wherein facial representation data of each of the members using the calling party number are stored at the Central Office).

Regarding claim 7. Bierman teaches wherein said data is stored by a telephone company (see col. 3 lines 19-30 and col. 4 lines 5-12 wherein Central Office stores facial representation data).

Regarding claim 8. Bierman teaches wherein the personalized caller id provides user's name (see col. 3 lines 54-58 wherein calling party's name, number and facial data are provided to called terminal between first and second ring burst).

Regarding claim 9. Bierman teaches wherein the user places said call using the given telephone number on one of a land line telephone, cellular telephone, VoIP appliance, videophone, or television phone (see items 30 and 42 in figure 2 and col. 2 line 63 – col. 3 line 4 wherein land line telephones are used).

Regarding claim 10. Bierman teaches a method of placing a telephone call (abstract) comprising:

creating at least one personalized caller id (see abstract, col. 3 lines 19-30, col. 4 lines 5-12 wherein subscriber makes available to the service provider a photograph or other graphic representation which is stored with calling party's number);

associating said at least one personalized caller id with a given phone number (see col. 3 lines 19-30, col. 4 lines 5-12 wherein photograph(s) are stored with calling party's number at the Central Office database);

selecting a particular personalized caller id for a given phone call originating from the given telephone number (see col. 4 lines 5-12 wherein subscriber indicates to the Central Office which facial representation is to be sent to called party's terminal); and

placing the phone call via the given telephone number to a called party (see col. 3 lines 45-58 and col. 4 lines 5-28 wherein the calling party places telephone call to called party);

wherein the selected personalized caller id is communicated with the phone call when the phone call is placed see col. 3 lines 45-58 and col. 4 lines 5-28 wherein the facial representation data is presented with other calling line identification information when calling party initiates a call).

Regarding claim 11. Bierman teaches at the called party, receiving and displaying the selected personalized caller id (see abstract and col. 3 lines 53-58 wherein facial representation data is sent to called party's terminal for display).

Regarding claim 12. Bierman teaches wherein the personalized caller id data comprises at least one of a photo, video clip, or multimedia presentation (see col. 3 lines 19-21 and col. 4 lines 5-12 wherein photograph or other graphic representation is supplied to Central Office for storage).

Regarding claim 13. Bierman teaches wherein the personalized caller id data is communicated by a calling telephone to a called telephone a the beginning of placing the phone call (see col. 3 lines 45-58 and col. 4 lines 5-28 wherein calling party initiates telephone call with an indication to the Central Office as to which facial representation is to be sent to called party's terminal).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 14-18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Lampela et al (6,757,533 hereinafter Lampela).

Regarding claim 14. Lampela teaches a telephone comprising a user interface (see calling party terminal 100 in figures 1-7) for:

enabling a user to program a personalized caller id (see abstract, col. 3 lines 59-65, col. 5 lines 15-61, col. 6 lines 36-40, col. 6 lines 49-53, col. 7 lines 25-52 wherein caller generates Rich Calling Line Identification Presentation data (i.e. personalized caller id data) to be delivered to called party terminal); and

enabling the said user to select said personalized caller id for transmission to a called party when placing a telephone call from said telephone (see abstract, col. 3 lines 59-65, col. 5 lines 15-61, col. 6 lines 49-53, col. 7 lines 25-52 wherein caller selects Rich Calling Line Identification Presentation data (i.e. personalized caller id data) to be set to a called party during call setup signaling).

Regarding claim 15. Lampela teaches wherein the personalized caller id comprises at least one of a text message, photo, video clip, or multimedia (see col. 5 lines 27-42 wherein Rich Calling Line Identification Presentation data (i.e. personalized caller id data) can vary from simple text, video, audio, still pictures, images, etc.).

Regarding claim 16. Lampela teaches wherein said personalized caller id is stored in said telephone (see abstract, col. 3 lines 59-65, col. 5 lines 18-20 , col. 5 lines 43-61, col. 6 lines 49-53, col. 7 lines 25-52 wherein caller delivers Rich Calling Line Identification Presentation data (i.e. personalized caller id data) from caller terminal).

Regarding claim 17. Lampela teaches wherein said personalized caller id is stored by a telephone company (see abstract, col. 3 line 66 – col. 4 line 8, col. 5 lines 18-20, col. 5 lines 52-61, col. 6 lines 16-23, col. 6 lines 36-40, col. 7 lines 42-44 wherein network (i.e. telephone company) stores Rich Calling Line Identification Presentation data (i.e. personalized caller id data) to be sent to called party).

Regarding claim 18. Lampela teaches wherein the personalized caller id data provides the user's name (see col. 5 lines 27-42 wherein Rich Calling Line Identification Presentation data (i.e. personalized caller id data) may simply be the name of the caller).

Regarding claim 20. Lampela teaches a telephone comprising one of land line telephone, cellular telephone, VoIP appliance, videophone, or television phone (see col. 8 lines 19-22 wherein cellular or land line phones may be used).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bierman et al (5,761,279 hereinafter Bierman) in view of Lampela et al (6,757,533 hereinafter Lampela).

Regarding claim 6. Bierman fails to teach wherein said data is stored in the user's telephone.

Lampela teaches a telecommunication system that provides Rich Calling Line Identification Presentation data (i.e. personalized caller id) to called party (abstract). Lampela discloses the calling party terminal is used to store the Rich Calling Line Identification Presentation data to be delivered to the called party (see abstract, col. 3 lines 59-65, col. 5 lines 15-61, col. 6 lines 49-53, col. 7 lines 25-52) for the purpose of allowing the calling party to instantaneously take a picture and immediately sending the

picture to the called party as personalized caller id (col. 3 lines 34-37, col. 5 lines 34-58, col. 7 lines 44-48).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teaching of Lampela into the teachings of Bierman in order to allow the user to send temporary multimedia data to the called party

4. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lampela et al (6,757,533 hereinafter Lampela) in view of Chelliah et al (6,711,402 hereinafter Chelliah).

Regarding claim 19. Lampela does not teach wherein a plurality of users are able to program their own personalized caller id for selection and transmission to a called party when placing a telephone call from said telephone.

Chelliah teaches a method and apparatus that provides personalized caller id (col. 1 lines 13-17) wherein a temporary user of a mobile phone (i.e. plurality of users) is allowed to enter a given name or nickname or trademark into the phone for delivery to the called party prior to making the call (col. 2 lines 57-63, col. 6 lines 39-60) which enhances personal mobility concepts which are currently being emphasized throughout the telecommunications industry.

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of Chelliah into the teachings of Lampela in order to

provide a more useful telephone that allows a temporary user the ability to personalize caller identification information to be sent to called party before placing a telephone call.

5. Any response to this action should be mailed to:

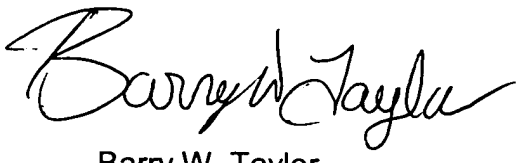
Commissioner of Patents and Trademarks
Washington, D.C. 20231
or faxed to:
(703) 872 9314,
(for informal or draft communications, please label "PROPOSED" or "DRAFT")
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry W. Taylor, telephone number (703) 305-4811, who is available Monday-Friday, 6:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached at (703) 305-4708. The facsimile phone number for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 2600 receptionist whose telephone number is (703) 305-4750, the 2600 Customer Service telephone number is (703) 306-0377.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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